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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/535,827	03/24/2000	Domenico Orzi	252/128	2029

34026 7590 01/09/2003

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EXAMINER

CHANG, AUDREY Y

ART UNIT PAPER NUMBER

2872

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/535,827

Applicant(s)

ORZI ET AL.

Examiner

Audrey Y. Chang

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 2 is/are allowed.
- 6) ☒ Claim(s) 5-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Remark*

- This Office Action is in response to applicant's amendment filed on July 22, 2002, which has been entered as paper number 10.
- By this amendment, the applicant has amended claims 5, 15, 25 and 26 and has canceled claims 3 and 4.
- Claims 1-2 and 5-26 remain pending in this application.
- The rejections to claims 5-14, 15-24, 25 and 26 under 35 USC 112, first paragraph, set forth in the previous Office Action dated December 28, 2001 *still hold*.
- The rejections to claims 5-14, 15-24, 25 and 26 under 35 USC 112, second paragraph, set forth in the previous Office Action dated December 28, 2001 *still hold*.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 5-14, 15-24, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

*The reasons for rejection are set forth in the previous Office Action dated December 28, 2001.*

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Claims 5-8, 15-18, 25 and 26, recite that the transparent substrate is selected from the group consisting the claimed elements that are *not supported* by the specification. Although the specification teaches various *applications* for the optical filter however the specification fails to teach adequately how each element is *actually employed* as the transparent substrate. (*Applicant is respectfully noted that applying the construction to the various applications does not give the adequate teachings as to use the various applications as the substrate.*)

Claims 5, 15, 25 and 26 recite that the first and second reflecting areas cooperate to define a pattern that is visibly perceptible when viewed from the front side and imperceptible when viewed from the back side of the substrate. The specification fails to teach adequately as how could by having partially reflective coatings on the first and second areas would achieve such. The essential element for making such perceptible and imperceptible characters is the metallic layers with different thickness. These claims as stand now are therefore not enabling the claimed characteristics. (*The applicant is respectfully noted that claims are interpreted in light of the specification however the limitations of the specification do not read into the claims.*)

Claims 9 and 19 recite that the predetermined could be “devices” that is not supported by the specification, since it fails to teach how could the pattern of the filter elements be “devices”.

Claims 6-14, and 16-24 inherit the rejection from their respective based claim.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 5-14 and 15-24 and 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

*The rejections are set forth in the previous Office Action dated December 28, 2001.*

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The alternative phrase concerning the transparent substrate being selected from the group consisting various elements recited in claims 5, 15, 25 and 26 is indefinite since the elements in the group *are not equivalent to each other*, which therefore renders the scope of the claims unclear. **Claims 5, 15, 25 and 26 have been amended** to recite that the group further consisting of a transparent plastic film, which makes the scope of the group therefore the claims even more unclear and indefinite. It is implicitly true that a plastics film is *not equivalent* to an architectural glass. A windscreen is *not equivalent* to a lenses. A skylight is *not equivalent* to a visor, etc.

The alternative phrase concerning the pattern being selected from the group consisting various elements recited in claims 9 and 19 is indefinite since the elements in the group *are not equivalent* to each other, which therefore renders the scope of the claims unclear. The specification and the claims fail to define the term "devices" which therefore fail to give the proper scope for the claims.

Claims 6-14 and 16-24 inherit the rejections from their respective claims.

The phrase "a first metallic thin film" recited in claim 23 and the phrase "a second metallic thin film" recited in claim 24 are indefinite since it is not clear how do they relate to the "first metallic thin film" and the "second metallic thin film" recited in *the amended based claim 15*. *Claim 15 has been amended to include the phrases "first metallic thin film" and "second metallic thin film"*.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 5-14, 16-24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent issued to Dillon (PN. 4,715,702) in view of the patent issued to Apfel et al (PN. 3,679,291).

Dillon teaches a decorative lens that is comprised of a *transparent substrate*, (28), a *first partially reflective coating* that is comprised of a *first optical element* (29) and the corresponding first area of a *reflective element* (27) for reflecting *red light* and a *second partially reflecting coating* that is comprised of a *second optical element* (31) and the corresponding second area of the *reflective element* (27) for reflecting *blue light*, (please see Figure 4 and column 4). The two reflective coatings define a two-colored pattern. Dillon teaches that the reflective element (27) and the colored transparent substrate (28), which therefore has absorption property, function in such way that the two-colored pattern may be *visibly perceptible* by an observer (35) from the front side of the substrate but *visibly imperceptible* when viewed by a viewer (36) from the back side of the substrate, (please see Figure 4).

This reference has met all the limitations of the claims with the exception that it does not teach explicitly that the first and second optical elements (29 and 31) for respectively reflecting red and blue light are of optical thin films or of dielectric film. Apfel et al in the same field of endeavor teaches a filter coating having asymmetric reflectance wherein thin film layers such as dielectric layers are used to provide reflection for *different* color of light. It would then have been obvious to one skilled in the art to apply the teachings of Apfel et al to make the color optical elements (29 and 31) of Dillon with *thin film structure* including dielectric films for the benefit of providing an alternative and well-known structure for the color filter elements to make the decorative lens.

With regard to claims 13-14, amended claims 15 and 26, and 23-24, Dillon also does not teach explicitly that the reflective element is metallic thin film. Apfel et al in the same field of endeavor teaches a multi-chromatic optical filter that has a metal layer (26) placed underneath film layers forming an optical coating that serves as an absorbing layer such that the color appearance of the filter will not be

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observed when viewed from the back side of the substrate, (please see Figure 1, column 10). It would then have been obvious to one having ordinary skill in the art to apply the teachings of Apfel et al to replace the reflective element (27) of Dillon by a metal layer for the benefit of providing an alternative and well-known means for achieving the same purpose as to make the color feature of the decorative lens imperceptible from the back side of the lens. The reflective element or the metal layer certainly has predetermined thickness, and the reflective areas corresponding to the first and second optical elements certainly each has a predetermined thickness.

With regard to claims 5-8, 15-18, 25 and 26, Dillon teaches the substrate is a lens for sunglasses, (please see column 1 and 3, Figures 1, 3A-3D, and 6). Although this reference does not teach explicitly that the substrate can also be the various elements, however the specification of the instant application does not teach such either. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is *intended to be employed* does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Madham, 2 USPQ2d 1647 (1987).

With regard to claims 9-12, and 19-22, Dillon teaches that the decorative pattern of the color fields may be in the form of a logo, (please see Figures 1, 3D and 4).

### *Reissue Applications*

7. Claims 5-26 are rejected under 35 U.S.C. 251 as being an improper recapture of *broadened claimed* subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not

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present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

### *Response to Arguments*

8. Applicant's arguments filed on July 22, 2002 have been fully considered but they are not persuasive. The amended claims have been fully considered and they are rejected for the reasons stated above.

9. In response to applicant's arguments which state the cited Dillon and Apfel references do not teach a thin-film based optical coating which therefore differ from the instant application the Examiner respectfully disagrees for the reasons stated below. Firstly, both Dillon and Apfel references teach that the optical coatings are formed of single coating layer. Apfel reference further teaches that the optical coating may have either a *single film* or a *multiple of thin films* construction which are known in the art as interference filter, namely the thickness of the thin film layer or layers determines the transmittance and reflectance property of the filter. Secondly, optical coating that is based on thin-film construction are notoriously well known in the art. The applicant is respectfully directed to standard textbook such as "Thin-Film Optical Filters" by Macleodo, McGraw Hill, 1986, wherein standard knowledge of forming optical coatings such as optical filters using thin film construction are well taught. The feature concerning the optical coating being thin film based is therefore not a patentable feature.

### *Allowable Subject Matter*

10. Claims 1 and 2 appear to be allowed over the prior art references of the record.

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11. The following is a statement of reasons for the indication of allowable subject matter: of the prior art references considered none has disclosed an optical filter arrangement, with the claimed structures, that includes a first and second reflective layer and at *least one transmission balancing means* that is comprised of *at least a first metallic thin film of predetermined thickness* and a *second metallic thin film of the same material* as the first metallic thin film and of a **predetermined thickness which is different** to the predetermined thickness of the first metallic thin film. The first and second reflective layers reflects light of different wavelength and such reflective pattern is perceptible by an observer from the front side of the filter arrangement and is imperceptible by the observer from the opposite side of the filter arrangement.

*Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

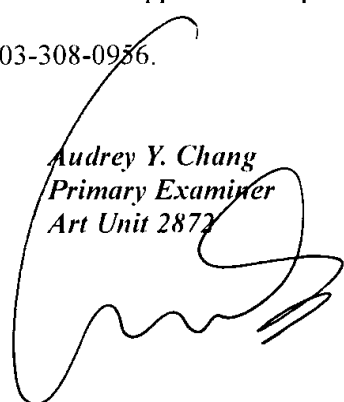
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Audrey Y. Chang whose telephone number is 703-305-6208. The examiner can normally be reached on Monday-Friday (8:00-4:30), alternative Mondays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703-308-1637. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0936.

*Audrey Y. Chang*  
*Primary Examiner*  
*Art Unit 2872*

A large, stylized handwritten signature in black ink, which appears to be 'Audrey Y. Chang', is written over the typed name and title.

A. Chang, Ph.D.  
January 8, 2003